

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No:	10/598,547	Confirmation No.:	7161
Filing Date:	24 June 2007		
First Named Inventor:	Filippo Ramin		
Attorney Docket No.:	06UVB006		
Examiner:	Philip Kwon		
Art Unit:	3634		
Customer No.:	39232		

Commissioner for Patents
P.O. Box 1450
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RESPONSE TO ELECTION REQUIREMENT

Sir:

In response to the Election Requirement dated 10 March 2009, Applicant hereby elects Species 1, which corresponds to FIG. 4. The claims readable on Species 1 are 38-49, 51-55, 58-65 and 69-73. This election is made with traverse for the following reasons.

The Office Action has stated that none of the pending claims are generic. It is submitted that claim 38 is the only independent claim in the application and that dependent claims 39-73, which cover the four alleged species, necessarily include all the limitations of claim 38. Therefore, the elements of claim 38 cover all of the four alleged species, making claim 38 generic.

Moreover, the differences among the embodiments of FIGS. 4-7 reside essentially in the opening mechanisms, and a large number of claims among dependent claims 39-73 include

limitations that do not relate to the opening mechanisms and that are common among the four alleged species. As examples but without limitation, claims 39-40 add elements related to the cross-section profiles of the frame and casements, and claims 44-46 add elements related to insulating properties.

Furthermore, certain dependent claims are written as Markush-type claims and recite limitations that cover some or all of the four alleged species. One example is claim 63.

MPEP 808.01 states that an election of species is proper only if an unduly extensive and burdensome search would be necessary if the election were not requested. MPEP 808.02 clarifies that burden is established if a separate classification of the species, a separate status in the art, or a different field of search are required. The Office Action has provided no indication that any of these conditions is present here, and the foregoing discussion shows instead that no unduly extensive or burdensome search would be required because searching for claims 38 and the majority of the dependent claims would necessarily include a search that would cover all of the embodiments of FIGS. 4-7.

Finally, the position set forth in the Action, that a traversal of this requirement for election on the ground that different embodiments of the same invention are presented may be considered an admission of obviousness in a subsequent prior art rejection of one species in view of the other ones, is believed improper and contrary to the law.

It is believed clear that Applicant's teaching of equivalency in Applicant's own specification is not available to the Examiner as an admission in a rejection under 35 USC 103. Instead, the equivalence must be disclosed in the prior art. Any disclosure of equivalence in Applicant's specification cannot be used by the Examiner to support his rejection. See, *In re Ruff et al.*, 256 Fed. 2d. 590, 118 USPQ 340. Therefore, this portion of the Office Action corresponds to an improper use of Applicant's disclosure and Applicant's traversal of this election requirement cannot be used against him in future prosecution of this application.

An extension of time fee for a two-month extension of time is submitted concurrently herewith.

Dated: June 10, 2009

Respectfully submitted,

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